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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,236	08/21/2001	Johann Klein	H-3497 PCTUS	3870

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/23/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,236

Applicant(s)

KLEIN ET AL.

Examiner

Katarzyna W. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: .

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 14, 15, 18, 19, 23, 26-28, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Use of term "other type" renders claims 14, 15, 18, 19, 23, 26 indefinite. Ex Parte Copenhagen, POBA, 1955, 109 USPQ 118-119.

The term 'other' in claim 27 is also indefinite for two reasons. It is not clear if the term "other additives" means earlier described fillers. Second, the specification only gives an example of additives, which does not exclude other additives not taught by the specification.

In claim 28, the scope of the preamble is indefinite, since it is not clear what the applicant is attempting to claim. At the time of this office action, the claim discloses a process for preparing a surface coating, which is an article, a surfacing compound, sealing compound and molding composition. In addition, claim 30 is confusing, since it is not clear, which article is being claimed. Claim 30 is oriented towards a coating composition, compound, an adhesive and molding composition.

As evidence to support this rejection, it is noted that "an essential purpose of patent examination is to fashion claims that are precise, clear, correct and unambiguous. Only in this

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way can uncertainties of claim scope be removed as much as possible, during administrative process” (see MPEP 2106 citing *In re Zletz*, 893 F.2d 319, 321-322, 13 USPQ 1320, 1322 Fed. Cir 1989).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 12, 14-23, 25-26, 28, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Jobbins (US 6,171,388 B1).

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Claim 1 of the prior art of Jobbins discloses composition for wallboard comprising gypsum, synthetic or natural polymer latex and nonionic surfactant. The surfactant is present in the amount of 0.05-0.3 parts by weight.

The polymers disclosed in claims of the prior art of Jobbins include those having monomers selected from methacrylic acids and esters, styrene, divinyl benzene, vinyl esters, butadiene, vinylidene chloride and vinyl chloride. Preferred embodiment taught in claim 5 is styrene homopolymer or copolymer of styrene with acrylic acid or ester. According to claim 1, polymeric component is utilized in the amount of 0.25-10 parts by weight.

The examples show that water is utilized to make the slurry therefore the polymers utilized in the prior art of Jobbins are either water-soluble or water dispersible.

According to claim 10 of the prior art of Jobbins, additives include water, fillers and aggregates among many. One of the additives is pigment, wherein the specification lists total of three. Among the three pigment titanium dioxide is listed. The amount of fillers is 0-500 parts by weight per 100 parts by weight of gypsum, wherein $(500/600) \times 100 = 83.3\%$.

Specification further provides teaching that the gypsum is crushed and milled to particle size of 25 microns and that the gypsum utilized in the composition can be obtained waste gas desulfurization process in conjunction with naturally occurring gypsum. Since the present claims do not exclude the presence of naturally occurring gypsum, the prior art of Jobbins applies.

The component of the composition of Jobbins are combined and molded into an article. Examples recite test shapes of 1-inch cubes. Examples disclosed in the prior art of Jobbins, for

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example 6) also disclose that a polymer is in slurry form, before the surfactant has been added to it.

In the light of the above disclosure the prior art of Jobbins anticipates requirements of claims rejected above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jobbins (US 6,171,388 B1).

In the event, that the anticipation rejection is successfully overcome, it is examiner's position that it would have been obvious to one having ordinary skill in the art to utilize titanium dioxide and thereby obtain the claimed invention, since titanium dioxide is explicitly taught in the prior art of Jobbins.

In addition to the titanium dioxide pigment, the prior art of Jobbins teaches use of fillers such as clay, sand (SiO_2), which can be added to the composition. Further there is a recitation of calcium sulfate, wherein calcium is a group IIA metal just like barium.

Additives utilized in the prior art of Jobbins are added to give white color in case of titanium dioxide or to obtain crystals having better aspect ratios in case of calcium sulfate. Others such as clay are simply fillers.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize optional fillers and additives of the prior art Jobbins in addition to titanium dioxide and thereby obtain the claimed invention. Use of the fillers of Jobbins would give composition desired properties as discussed above. In addition, the prior art of Jobbins explicitly lists some of the fillers or additives of the present invention.

9. Claims 13, 16, 20, 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jobbins (US 6,171,388 B1) as applied to claims 12, 14-23, 25-26, 28, 30 above, and further in view of Meinhardt (US 5,852,063).

The discussion of the disclosure of the prior art of Jobbins from paragraphs 7 and 8 of this office action is incorporated here by reference.

The difference between the present invention and the disclosure of the prior art of Jobbins is recitation of the gypsum particle size of 30-250 microns. Also addition of the fillers into the polymer slurry and the type of the polymer.

With respect to the above difference, the prior art of Meinhardt discloses another composition comprising polymer, gypsum, water and inorganic fillers, which composition is a sealing composition or sealing plaster as well as a composition, which can be molded into complex shape.

The prior art of Meinhardt discloses that the gypsum has particle size of at least 50 microns (col. 5). The FDG abbreviation in the prior art of Meinhardt arises fuel gas desulphurization.

The polymer of the prior art of Meinhardt is urethane type polymer formed from polyisocyanate pre-polymer and polyol in presence of catalyst.

Example 1 in the prior art of Meinhardt further discloses a process, where polymer slurry is first formed and the slurry is mixed. Separately additives and fillers including gypsum are mixed. The two mixtures are then combined together in 1:1 ratio.

Gypsum is utilized in the composition such as those cited above, because it can release water and thereby inhibits attacks by flames. Gypsum filler of particle size as that in the prior art of Meinhardt can efficiently serve in that capacity. Also, addition of the fillers after the polymer has been incorporated into the dispersion such as in case of Meinhardt would prevent settling and premature reaction between the components of the composition.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize the components of Meinhardt such as polymer, gypsum having larger particle size and process of combining the components in the prior art of Jobbins and thereby obtain the claimed invention. Using the components of Meinhardt, having the two disclosures at hand, one of ordinary skill in the art would be able to arrive at a composition that can be molded into an article or seal two or more surfaces together. Both compositions comprise polymer, gypsum, additive and filler.

10. Claims 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jobbins (US 6,171,388 B1) as applied to claims 12, 14-23, 25-26, 28, 30 above, and further in view of Nakamura (US 5,298,542).

The discussion of the disclosure of the prior art of Jobbins from paragraph 7 and 8 of this office action is incorporated here by reference.

The difference between the present invention and the disclosure of the prior art of Jobbins is recitation of other additives and fillers, required by claims 15 and 19 of the present invention.

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With respect to the above difference, the prior art of Nakamura discloses acrylic based plastisol composition, which just like other prior art disclosures can be utilized as building material molding composition, coating composition or a foamed product.

The composition discloses addition of additives such as plasticizers, thixotropic agents, adhesive agents and surface active agents. Fillers of Nakamura include titanium dioxide pigment, also chalk, barium sulfate, clay, talk, silicas and gypsum.

Fillers such as titanium dioxide pigment, also chalk, barium sulfate, clay, talk, silicas and gypsum are suitable for making compositions that have use in building materials such as insulations or wallboards, coatings or adhesives in conjunction with polymer component.

Selection of a known material based on its suitability for its intended use supports *prima facie* obviousness. *Sinclair & Carroll Co vs. Interchemical Corp.* 325 U.S. 327, 65 USPQ 297 (1945). MPEP 2144.07.

In the light of the above disclosure, having the two disclosures at hand, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize the fillers of Nakamura in the composition of Jobbins and thereby obtain the claimed invention. The fillers of the prior art of Jobbins such as titanium dioxide, clay or Group IIA sulfate overlap with the fillers of the prior art of Nakamura. The addition of other fillers would still afford composition that can be molded, used as a coating or adhesive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna W. Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KIWL

October 21, 2002